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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,733	04/03/2002	Amanda Hawthorne	2296.2330	6305
5514	7590	02/25/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WINAKUR, ERIC FRANK	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/831,733	HAWTHORNE ET AL.	
	Examiner	Art Unit	
	Eric F Winakur	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) 20-26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

2. Claims 20 - 26 are objected to because of the following informalities: it appears that the term "determined" (claim 20, line 7) should be deleted. Further, it appears that the method should clearly limit the determining step to determining the percentage body fat from a relationship between 'only' (or 'solely') the first and second body measurements, as Applicant has argued that it is this arrangement that distinguishes from the prior art. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The incorporation of non-statutory descriptive material (a look-up table) on a computer readable medium does not in itself make the material statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.")

(quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also MPEP 2106.

Claim Rejections - 35 USC § 103

4. Claims 1 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanton et al. in "Bioelectrical impedance and zoometry ...". Stanton et al. discloses the claimed invention (means for measuring) except for the specific arrangement and/or content of indicia (printed matter) set forth in the claims (in particular see claims 1, 4 - 6, 8 - 11, 13, 14, and 17 - 19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the particular look-up tables since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information regarding body fat in pet mammals does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate or means for measuring which is required for patentability.

Further, it is noted that the claims require means for measuring a first body dimension and means for measuring a second body dimension. While Stanton et al.

disclose performing all of their measurements with a metric tape measure (see p. 252, "Zoometric measurements" section), it is well recognized that tape measures and rulers are alternate equivalent expedients, each having advantages and disadvantages for particular zoometric measurements. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Stanton et al. to include a ruler in addition to the tape measure for performing the measurements. Alternately, as the tape measure of Stanton et al. can perform both measurement functions recited in the means clauses, the tape measure by itself reads on the two means or it would have been within the skill level of the art to provide a second tape measure, as this is merely a duplicate of the disclosed element. Examiner does not consider the intended measurement performed by the device (see claims 2, 3, 12, 15, 16) to affect the structure of these means beyond defining certain dimensions that the elements must be capable of measuring. The measurements of Stanton et al. are within the same dimension ranges.

Response to Arguments

5. Applicant's arguments filed 23 November 2004 have been fully considered but they are not persuasive. Applicant attempts to differentiate the apparatus and systems of claims 1 - 19 from Stanton et al. based on differences in their respective methods of use. However, this is not the proper comparison. It is differences in structure that must distinguish an apparatus from the prior art. In this case, Applicant's claimed structure is merely means for measuring a first body dimension and means for measuring a second body dimension (one of which is a tape measure, or its equivalent, and the other which

is a ruler, or its equivalent) and a look-up table, the contents of which cannot serve to distinguish over the prior art. As detailed in the prior Office Action, Stanton et al. teach a metric tape measure to take multiple measurements, which is considered to either disclose the claimed means or is within the skill of the art to be modified to include these means. Applicant's arguments regarding the look-up table are noted; however, as discussed in the prior Office Action, the particular data in the look-up table is not given patentable weight. Thus, contrary to Applicant's assertions, there is no patentable difference between the structure of the instant invention and Stanton et al.

Allowable Subject Matter

6. The following is a statement of reasons for the indication of allowable subject matter: As Applicant notes, their method is based upon determining the percentage body fat of a four legged domestic pet mammal based on a relationship between two measured body dimensions. The closest prior art (Stanton et al.) is based upon a relationship between six measured body dimensions. There is no suggestion in the prior art to modify Stanton et al. to only require two measurements to determine body fat percentage. Thus, the prior art does not teach or suggest the claimed method.

7. Claims 20 - 26 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571/272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur
Primary Examiner
Art Unit 3736

22 February 2005